

REMARKS

Favorable reconsideration of the present application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1, 2 and 5-16 are presently pending in this application, Claims 1 and 2 having been withdrawn from consideration by the Examiner, Claim 5 having been amended, and Claims 11-16 having been newly added by this amendment.

In the outstanding Office Action, Claims 5-10 were rejected under 35 U.S.C. §112, first paragraph, as containing subject matter not described in the specification; and Claims 5-10 were rejected under 35 U.S.C. §112, second paragraph, for being indefinite.

Newly added Claims 11-16 find clear support in the original specification, claims and drawings. For example, Claims 11-16 are supported by Claims 5-10, Figures 1 and 2, and page 8, lines 8-14, of the specification.¹ Hence, no new matter has been added thereby.

The outstanding Office Action asserts that Claims 5-10 were rejected under 35 U.S.C. §112, first and second paragraphs. It has been long established that “[a]n amendment to correct an obvious error does not constitute new matter where one skilled in the art would not only recognize the existence of error in the specification, but also the appropriate correction.”² In rejecting Claims 5-10 under 35 U.S.C. §112, first paragraph, the Office Action clearly states that “the specification, while enabling for moving a cutting blade greater than 0 mm/minute, does not enable reasonably provide enablement for moving the blade at a speed

¹ MPEP 2163 states that “[p]rior to determining whether the disclosure satisfies the written description requirement for the claimed subject matter, the examiner should *review the claims and the entire specification, including the specific embodiments, figures, and sequence listings, to understand how applicant provides support for the various features of the claimed invention*” (emphasis added in *Italic*).

² MPEP 2163.07, citing *In re Oda*, 443 F.2d 1200, 170 USPQ 268 (CCPA 1971).

less than 0 mm/minute” and that “[s]peed is an absolute value.” Also, in rejecting Claims 5-10 under 35 U.S.C. §112, second paragraph, the Office Action further states that “speed is always a positive number (absolute value).” In addition, one ordinarily skilled in the art would be able to recognize that speed and velocity are often used synonymously as described in major standard dictionaries. Thus, based on the reading of the specification, it is quite apparent to one ordinarily skilled in the art that “speed” can also means velocity, thus any negative values for β would be unworkable and α is necessarily a value which always gives rise to β of more than 0 mm/minute. Therefore, Claim 5 has been amended to recite “when the speed β is positive, the cutting blade moves in a direction for cutting the optical fiber,” and Claims 5-10 are thus believed to overcome the outstanding rejections under 35 U.S.C. §112, first and second paragraphs, without introducing new matter.

Also, as submitted in the Response to the previous Office Action, Applicants wish to point out that for cutting the optical fiber by moving the cutting blade, the cutting speed of the cutting blade should be more than zero as a matter of course as confirmed by the statements in the Office Action itself. It is therefore respectfully submitted that given the mathematical expression, $\beta \leq -253\alpha + 65$ (mm/minute), recited in amended Claim 5, one ordinarily skilled in the art would be able to *reasonably* recognize and practice *without undue experimentation* that the speed of the cutting blade would be more than zero even without the amendment thereto.³

³ MPEP 2164.08, stating that “[a]ll that is necessary is that one skilled in the art be able to practice the claimed invention, given the level of knowledge and skill in the art,” that “[f]urther the scope of enablement must only bear a “reasonable correlation” to the scope of the claims,” and that “[t]he second inquiry is to determine if one skilled in the art is enabled to make and use the entire scope of the claimed invention without undue experimentation.”

If, however, the Examiner disagrees with any of the claim amendments discussed above, the Examiner is invited to telephone the undersigned who will be happy to work in a joint effort to derive a mutually agreeable claim language.

In view of the amendment and the discussions presented above, it is respectfully submitted that the present application is in condition for allowance, and an early action favorable to that effect is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Gregory J. Maier
Registration No. 25,599
Robert T. Pous
Registration No. 29,099
Attorneys of Record



22850

Tel: (703) 413-3000

Fax: (703) 413-2220

GJM/RTP/AY:fmw

I:\ATTY\AKY\0s\0041\00410619cpa_ame.wpd

Marked-Up Copy

Serial No: 09/160,581

Amendment Filed on:

8-19-02

IN THE CLAIMS

Please amend Claim 5 and new Claims 11-16 as follows:

--5. (Thrice Amended) A method for cutting an optical fiber, for cutting the optical fiber by moving a cutting blade, comprising a step of moving the cutting blade having a blade thickness α (mm) at a speed β (mm/minute) relative to the optical fiber during the cutting, wherein $\beta \leq -253\alpha + 65$ (mm/minute), and when the speed β is positive, the cutting blade moves in a direction for cutting the optical fiber.

11. (New)

12. (New)

13. (New)

14. (New)

15. (New)

16. (New)--